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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/698,943

Filing Date: November 03, 2003

Appellant(s): GRAVELLE, KELLY

MAILED

DEC 11 2007

Kelly Gravelle
For Appellant

GROUP 2800

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 17, 2007 appealing from the Office action mailed April 13, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5819234	Slavin et al.	10-1998
5892211	Davis et al.	04-1999
6595416	Newsome et al.	07-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slavin et al. (US 5,819,234) in view of Davis et al. (US. 5,892,211).

Re claims 1-3, 14-16, 26, 32-34, 45 and 51, Slavin discloses an automatic toll collection system and method comprising and operating in conjunction with transponders (an electronic toll collection device) which are provided for sale to the public in sealed packages and which are pre-approved for a predetermined amount of prepaid toll credit. When the transponders are purchased, they can be installed in any vehicle and are immediately ready for use. The kit in which the transponder is sold includes application forms and a return mailer which permit the purchaser thereof to convert the pre-established anonymous account to a regular prepaid toll account and to authorize the automatic replenishment of the account (this may be done via the Internet), thus enabling continued use of the purchased transponder beyond the pre-approved amount. The invention further comprises the process of frequent updating, e.g. several times daily, hourly, etc. of toll plaza computers with toll transactions at all participating toll facilities, to prevent inadvertent overdrawing of toll accounts by motorists. Slavin further discloses that the transponder, which may be distributed by a participating retail establishment such as a

Seven-Eleven™ or Wal-Mart™ or through the mail, is encoded at a central billing computer facility (CSC) with a predetermined toll balance amount, for example \$25. The toll collection system also includes a communication link (Internet) for providing communication between the processing device and a remote computer (central computer), and wherein the processing device provides the stored value (predetermined toll balance amount) by transmitting the stored value to the remote computer. It is then enclosed in a protective foil wrapper to shield it from unintentional use and packaged in a sealed kit for distribution to vendors and sale.

Slavin fails to explicitly disclose an electronic toll collection device that may be purchased at the self-service transactional terminal.

Davis discloses a device comprising a self-service transactional terminal (POS terminal 40 or vending machine terminal 50). The self-service transactional terminal comprises a payment acceptance device (a coil and/or bill receiving device 56) for accepting payment for a user-selected good/service, a dispenser (a dispensing opening 54) to dispense the user-selected good/service, and a processing device (col. 7, ll. 8-12), in electronic communication with the payment acceptance device and the dispenser, for providing a stored value of the user-selected good/service and controlling the dispenser to dispense the user-selected good/service in accordance with the payment accepted by the payment device. The user-selected good/service may be anything that an operator of the self-service transaction terminal provides. For example, if a booklet of stamps is provided by an operator of an ATM (another example of a self-service transaction terminal), a user may select an option to buy a booklet of stamp at the terminal. Generally, a plurality of ATMs is connected via a communication link and each ATM is located

at a different location. A self-service transactional terminal or a standalone vending machine is one of many well known retail establishments in the art.

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to sell the electronic toll collection device of Slavin using the self-service transaction terminal of Davis for the purpose of encouraging the usage of the electronic toll collection device while increasing the convenience of acquiring the device and operation of the device.

Re claims 4 and 17, Slavin in view of Davis discloses the system and method as recited in the rejected claims 1 and 5 stated above further comprising a display, in electronic communication with the processing device, for guiding a user in purchasing the electronic toll collection device (col. 5, line 19 - col. 6, line 17 of Davis).

Re claims 5 and 18, Slavin in view of Davis discloses the system and method as recited in the rejected claims 4 and 17 stated above, wherein the display comprises a touch screen for both guiding the user and receiving commands from the user (col. 4, ll. 22-39).

Re claims 6, 19 and 37, Slavin in view of Davis discloses the system and method as recited in the rejected claims 4, 17 and 35 stated above, further comprising a key pad (key pad 36 or keyboard 42) for receiving commands from the user.

Re claims 7, 20 and 38, Slavin in view of Davis discloses the system and method as recited in the rejected claims 1, 15 and 32 stated above, wherein the payment acceptance device comprises a cash acceptor for accepting the payment in cash (col. 6, ll. 57-65).

Re claims 8, 21 and 39, Slavin in view of Davis discloses the system and method as recited in the rejected claims 7, 20 and 32 stated above, wherein the payment acceptance device

further comprises a card reader (col. 7, ll. 1-10) for accepting the payment in electronic form through a card (SVC 20).

Re claims 9 and 22, Slavin in view of Davis discloses the system as recited in the rejected claims 1 and 15 stated above, wherein the payment acceptance device comprises a card reader (col. 7, ll. 1-10) for accepting the payment in electronic form through a card (SVC 20).

Re claims 10, 23, 27 and 40, Slavin in view of Davis discloses the system and method as recited in the rejected claims 1, 15 and 32 stated above, further comprising an input device for receiving a number (a unique tag number) of an existing electronic toll collection device, wherein the processing device increases the stored value for the existing electronic toll collection device in accordance with the payment accepted by the payment acceptance device. Slavin discloses a replenishment process of an existing tag account through the customer service center 72, which may be a self-service vending machine as discussed above.

Re claims 11, 24, 41 and 46, Slavin in view of Davis discloses the system and method as recited in the rejected claims 10, 23, 40 and 45 stated above, wherein the input device comprises a user input device for manual input of the number (via a keypad or a keyboard of a computing device of Davis).

Re claims 12, 25, 42 and 47, Slavin in view of Davis discloses the system and method as recited in the rejected claims 10, 23, 40 and 45 stated above, wherein the input device comprises a reader (bar code scanner; col. 5, ll. 49-52) for automatically reading the number from the electronic toll collection device.

Re claims 13, Slavin in view of Davis discloses the system as recited in the rejected claim 1 stated above, further comprising a bar code reader, in electronic communication with the

processing device, for reading a bar code from a document and for transmitting information in the bar code to the processing device, wherein the processing device associates the information in the bar code with payment accepted by the payment acceptance device (bar code scanner; col. 5, ll. 49-52).

Re claim 14, Slavin in view of Davis discloses the system as recited in the rejected claim 1 stated above, wherein the dispenser comprises a dispenser for issuing motor vehicle tax or license decals.

Re claims 28, 43, 48 and 49, Slavin in view of Davis discloses the system and method as recited in the rejected claims 27, 40, and 45 stated above, wherein the accounting computer is in communication with a violation processing center (col. 5, line 54 - col. 6, line 4 of Slavin) and controls the violation processing center not to process a toll violation if the stored value is increased within a predetermined time period after the violation.

Re claim 29, Slavin in view of Davis discloses the system as recited in the rejected claim 28 stated above, wherein the vending unit further comprises a bar code reader, in electronic communication with the processing device, for reading a bar code from a document and for transmitting information in the bar code to the processing device, wherein the processing device transmits the information in the bar code to the accounting computer for association with the payment accepted by the payment acceptance device (col. 5, ll. 49-56 of Davis).

Re claims 30 and 44, Slavin in view of Davis discloses the system and method as recited in the rejected claims 26 and 32 stated above, wherein the accounting computer is in communication with a toll facility (Roadside Collection Stations) at which the electronic toll collection device is usable for paying a toll, and wherein, when the electronic toll collection

device is used at the toll facility, the accounting computer deducts the toll from the stored value (col. 5, ll. 53+ of Slavin).

Re claim 31, Slavin in view of Davis discloses the system as recited in the rejected claim 26 stated above, wherein the accounting computer is in communication with a computer system operated for a public authority (central computer 40) for collection of motor vehicle taxes or fees, and wherein the accounting computer (local plaza computer 32) communicates an amount of the payment accepted by the payment acceptance device to the computer system operated for the public authority.

Re claim 35, Slavin in view of Davis discloses the system and method as recited in the rejected claim and 32 stated above, wherein the vending unit (vending machine terminal 50) comprises a display (532), wherein in step (a) comprises guiding the user through the display in purchasing the electronic toll collection device (col. 5, line 19 - col. 6, line 17 of Davis).

Re claim 36, Slavin in view of Davis discloses the system and method as recited in the rejected claim 32 stated above, wherein the display comprises a touch screen for both guiding the user and receiving commands from the user, and wherein the method further comprises receiving the commands from the user through the touch screen (col. 4, ll. 22-39 of Davis).

(10) Response to Argument

Claims 1-14

The appellant argues that the applied prior art lack or fail to suggest the present claimed invention comprising, among other components, a vending unit, a payment acceptance device, dispenser and processing device.

The examiner respectfully disagrees. One of the applied prior arts, Slavin et al. disclose a toll collection system including a retail establishment for a consumer to purchase a sealed kit (50) which contains a transponder (30), installation hardware (52), an installation template (54), and instructions for installation, terms and conditions for service (58), a wallet sized ID card (60) with a transponder number and a customer service telephone number imprinted thereon, and an application form (62) and a return mail envelop (64). Since the Slavin reference does not explicitly disclose the retail establishment, Davis et al. reference cures the deficiency.

Davis et al. disclose a vending machine terminal comprising a standard coin and/or bill receiving device (56), a plurality of selector buttons (58) to permit a purchaser to select items (52), a card receiving slot (60), and a dispensing opening (54). Preferably, the vending machine terminal (50) includes a processor or microprocessor which uses an operating program stored in memory to interact with the stored value card (20) for the transfer of value to enable the dispensing of one or more items. The vending machine terminal may be connected via a communication link to financial entities or POS terminals to access the designated account of the SVC cardholder to transfer or load values. As discussed previously, the items sold in the vending terminal are not limited to a particular product or service.

Therefore, it is interpreted that Slavin et al. in view of Davis et al. discloses, teaches, or fairly suggests the claimed invention.

The appellant further argues that the replenishment of the transponder taught in fig. 8 of Slavin et al. happens after the transponder is sold and is thus irrelevant to the operation of the vending unit.

The argument is not persuasive because the claims in the present application do not particularly and clearly recite such feature. Furthermore, Slavin et al. disclose a system that is capable of transmitting a value stored in a transponder at the time of replenishment. At the time of initial sale of the transponder, the stored value is set as twenty-five dollars as an example.

On page 6 of the Appeal Brief, the appellant states that the paragraph spanning pages 8 and 9 of the Final Rejection does not explain why it would have been obvious to a person having ordinary skill in the art with no knowledge of the present claimed invention to make such an incorporation.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, one of the cited prior arts, Slavin et al. substantially discloses all of the claimed feature with the exception of explicitly disclosing a vending unit as a retail

establishment. It is well-known that a vending machine retail set up does not require a clerk or operator to assist its user. A consumer/purchaser can operate the terminal by himself/herself to buy a product or service he or she desires. Thus, it is saving operating cost to the owner of the vending machine terminal (A form of a retail establishment).

In view of above discussion, it would have been obvious to combine the vending unit of Davis et al. with customer service center of Slavin et al. to minimize operating cost of CSC by replacing an operator-assisted retail setting with a self-service vending unit.

Claims 15-31

The appellant argues that Slavin et al. predetermines the stored value on each transponder and Davis et al. does not overcome that deficiency, since that reference does not teach any sort of accounting for the items sold.

As discussed above, the toll collection system of Slavin et al. is capable of maintaining accounting of items (transponders) sold. Not only is it capable of maintaining accounting of items, but also it is able to keep track of huge amounts of computer data and transactions including millions of customers and toll transactions through a customer service center (72) that operates a massive central computer 80. It is obvious that the customer service center is a second location at which maintains accounting of the items (transponders) sold.

Claims 32-44

The appellant argues nothing about the stored value is transmitted from the vending unit to any remote computer for maintaining account information regarding the electronic toll collection device.

As discussed above, the toll collection system of Slavin et al. is capable of maintaining accounting of items (transponders) sold. Not only is it capable of maintaining accounting of items, but also it is able to keep track of huge amounts of computer data and transactions including millions of customers and toll transactions through a customer service center (72) that operates a massive central computer 80. It is obvious that the customer service center is a second location. Davis et al. reference shows a vending machine terminal that is a kind of a retail establishment of Slavin et al.

Claims 45-49

The appellant argues that no payment is accepted through the original location where the transponder was bought in order to increase the stored value.

The examiner respectfully disagrees. Davis et al. disclose a transaction system that can transfer values of a stored value card. The reference further discloses that the communication link or path between SVC and the terminal could be contactless. The SVC is a contactless smart card that communicates wirelessly like a transponder of the toll collection system of Slavin et al. Furthermore, Newsome et al. reference was used in the Office Action mailed on January 14, 2005 disclose a system for dispensing and adding a value to fare cards. Of course, the fare cards can also be a type of a contactless smart card.

Claim 51

The appellant states that Slavin et al. does not disclose a step of receiving a command through the vending unit to check the account from the user through the user interface. And Davis et al. does not overcome that deficiency, since that reference does not teach any sort of accounting for the items sold.

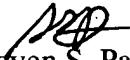
As discussed and explained above for claims 45-49, Davis et al. disclose a vending terminal that includes, among other things, a display and microprocessor which provides communicating information from the terminal to a SVC cardholder. The terminal is capable of maintaining accounting information of a SVC card. The SVC is a contactless smart card that communicates wirelessly like a transponder of the toll collection system of Slavin et al. Furthermore, Newsome et al. reference was used in the Office Action mailed on January 14, 2005 disclose a system for dispensing and adding a value to fare cards. Of course, the fare cards can also be a type of a contactless smart card.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Steven S. Paik

Primary Examiner

AU 2876

ssp

November 29, 2007

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10/698,943
Art Unit: 2876

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